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1 RECORD OF ORAL HEARING
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3 UNITED STATES PATENT AND TRADEMARK OFFICE
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5
6 BEFORE THE BOARD OF PATENT APPEALS
7 AND INTERFERENCES
8

9
10 *Ex parte* TIMOTHY ROBERT WEINSTOCK,
11 KIMBERLY ANN DEVALANCE,
12 RANDALL ALLAN HASELHORST, CRAIG STEPHEN KENNEDY,
13 DAVID GARY SMITH, WILLIAM T. TINGLE and
14 ANITA KAY KLOPFENSTEIN
15

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17 Appeal No. 2009-006237
18 Application No. 09/694,050
19 Technology Center 3600
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22 Oral Hearing Held: May 6, 2010
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25 Before MURRIEL E. CRAWFORD, JOSEPH A. FISCHETTI, and
26 BIBHU R. MOHANTY, *Administrative Patent Judges*.
27

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1 CLERK: Good morning. Calendar Number 29, Appeal No. 2009-006237,
2 Mr. Volk.

3 JUDGE CRAWFORD: Good morning.

4 MR. VOLK: Good morning.

5 JUDGE CRAWFORD: Could I ask you to concentrate on a portion of the
6 claim that I'm looking at?

7 MR. VOLK: Okay.

8 JUDGE CRAWFORD: That's the portion about a plurality of competitive
9 rental vehicle service providers and the acceptance by user. Is it your
10 position that's not taught by the prior art?

11 MR. VOLK: Correct.

12 JUDGE CRAWFORD: Could you talk about that a little bit?

13 MR. VOLK: Yes. The Examiner cites the Walker reference for that
14 teaching, and Walker addresses a situation where a buyer of rental vehicle
15 services submits what is called a conditional purchase offer -- CPO -- that
16 goes to a database and then multiple sellers can manually review those CPOs
17 in the database and issue an acceptance, or maybe a counter offer for a CPO,
18 or see if they were going to form a rental vehicle reservation.

19 With a system such as that, the buyer is not actually choosing the seller. The
20 seller is choosing the buyer, and it's our position that the person skilled in
21 the art would not have a reason or motivation to modify the many ways to
22 sell reference cited by the Examiner with the Walker reference cited by the
23 Examiner.

24 To incorporate Walker is kind of reverse option system into the 1995 ARM
25 system --

JUDGE CRAWFORD: But I don't think the Examiner is trying to incorporate Walker into ARM. I think it's the other way around. I think Walker is being modified by ARM and Brant in the Examiner's mind.

MR. VOLK: Even with a modification such as that, by modifying Walker to add the many ways to sell the 1995 ARM system, you still would have a buyer not selecting a seller. A buyer just issuing a conditional purchase offer, and a seller selecting a buyer.

The Declarations put in by one of the Inventors establishes why a person skilled in the art would believe that incorporating Walker's CPO-based system with the 1995 ARM system would actually not enhance reliability.

JUDGE CRAWFORD: But I think that Declaration was talking about how ARM was going to be made less efficient, if you incorporated Walker into it. I think the Examiner is talking about taking the ARM and putting it into Walker.

So I don't think that's -- because Walker is the major reference. Walker is modified. So I didn't get much out of reading those declarations because I didn't think that was the way the Examiner was using the reference.

MR. VOLK: Our reading of the rejection was that the Examiner was saying, you know, Walker teaches having multiple competitive rental vehicle service providers. The 1995 ARM system describes a system that provides reservation management functions and that the Brant system is kind of a tool for using the Internet to join those items.

The issue with combining Walker with the 1995 ARM system is there needs to be a reason for doing so for a person skilled in the art at the time of the invention.

1 As you look at what Walker does and what the 1995 ARM system does,
2 putting those two together would result in a situation where a user of the
3 Walker system, or the combined Walker 1995 ARM system, would still be
4 submitting conditional purchase offers through the 1995 ARM system for
5 reservation management purposes.

6 In a situation like that where the user is just submitting additional purchase
7 offers, that combination isn't going to have the claim feature where a
8 reservation is automatically created without human intervention on the part
9 of the selected rental vehicle service provider.

10 The reason for that is the Walker reference requires human intervention to
11 review those CPOs, decide which ones had acceptable terms, and if it's an
12 acceptable term, they'll accept it. But if they review that and they find they
13 think the price is too low, they'll issue counter offers and Declaration (b)
14 from Mr. Smith establishes why a person having skill in the art wouldn't
15 have a reason for doing that. It destroys the efficiency of the 1995 ARM
16 system.

17 JUDGE CRAWFORD: Why wouldn't you just use the system -- this Flow
18 Mark system -- to take the human intervention out?

19 MR. VOLK: The Flow Mark system actually doesn't teach taking the
20 human intervention out. What Flow Mark teaches is if the system porting to
21 the Internet is an automated system, you keep the automation. If the system
22 you're taking to the Internet requires human intervention, it would keep that
23 human intervention in the process model.

24 JUDGE CRAWFORD: Where is that in Brant?

1 MR. VOLK: Let's see -- on page 30 of the Brief, it cites to Brant at Column
2 17, lines 55 - 59. It's talking about the process models.
3 It's taken to the Internet through Brant's Flow Mark application, and at that
4 passage Brant teaches some process models may -- the important word there
5 is may -- may model an activity as a completely automatic process which
6 runs to completion without any human intervention.
7 Alternatively, a process model may require extensive human input and
8 intervention before it finishes the model process.
9 So it's our position that a person skilled in the art would look at Brant on this
10 subject and apply this teaching, where Walker's CPO driven model that
11 requires sellers to manually review these CPOs and decide on whether any
12 CPO should be accepted, would recognize that Walker is a process model
13 that requires extensive human input and intervention. So Brant actually does
14 not provide any teaching for completely teaching Walker's principle of
15 operation.
16 JUDGE CRAWFORD: Those are the questions I had. You can go on.
17 MR. VOLK: With this application and as we discussed, it's our position the
18 Examiner clearly erred in rejecting the claims for obviousness. There's three
19 primary grounds of attack that are set forth in the Appeal Brief.
20 The first is that the Examiner's reported or alleged motivation or reason for
21 combining Walker with the 1995 ARM system and Brant reference was
22 clearly erroneous. We talked through those issues.
23 We feel the unrefuted evidence of record in this Application establishes that
24 combining Walker with the other cited references would not actually

1 enhance reliability and dependent service, as alleged in the Office Action.
2 That's addressed in the Brief at page 10, pages 13 to 18.
3 It's our position that the unrefuted evidence -- the record actually shows that
4 the efficiency and reliability would actually be degraded from combining
5 Walker with the cited references.
6 Another issue is that we believe the Examiner's alleged reason and
7 motivation for combining Brant with the 1995 ARM system and the Walker
8 reference is completely erroneous.
9 Here again, we feel the unrefuted evidence of record in the patent
10 application establishes that a person having ordinary skill in the art would
11 not employ Brant in a business-to- multi-business system such as claimed, or
12 even a business-to-business system like the ARM invention, because the
13 Brant reference is not really suitable for business-to-business applications.
14 That's explained in the Declaration of Russell Dittmar, and that Declaration -
15 - he corroborates that with another IBM patent. IBM is the owner of the
16 Brant reference.
17 In a later patent filing, IBM itself recognizes the Brant system is not really
18 suitable for --
19 JUDGE CRAWFORD: He didn't say it wasn't suitable.
20 MR. VOLK: I believe it said --
21 JUDGE CRAWFORD: It just says it's better suited for, he didn't say it was
22 not suitable.
23 MR. VOLK: Even with a statement that it's better suited would be a
24 teaching that would be interpreted by a person having ordinary skill in the
25 art not to look to the Brant reference in a business-to-business application.

1 Then it's also Applicant's position that even if you were to accept the
2 Examiner's reasons for combining Brant with the 1995 ARM system with
3 the Walker reference, the resultant combination is still going to be lacking
4 two important features of the claims.

5 That first feature of the claim we discussed initially was the feature where
6 the buyer can actually select the rental vehicle service provider with which
7 he does business; and the second feature is that the buyer is able to
8 automatically book a rental vehicle reservation with the selected rental
9 vehicle service provider without any human intervention on the part of that
10 rental vehicle service provider.

11 There's another matter with this patent application just on a technical matter.
12 The Examiner refused to give any substantive consideration to the
13 Declaration of David Smith, and the Declaration of Russell Dittmar. The
14 only mention the Examiner made of these Declarations in the Office Actions
15 was on page 19, the August 15, 2006, Office Action.

16 It's just a statement that the Examiner isn't considering those Declarations
17 because they are mere statements of opinion, and they are self-serving
18 because Mr. Smith and Mr. Dittmar are employees of the Applicant.

19 JUDGE CRAWFORD: The Examiner didn't say he's not going to consider
20 it. He's just saying the weight he was going to give to them, in my view,
21 because they were conclusory in nature.

22 MR. VOLK: He never addresses any of the content of those Declarations,
23 so the only content he addresses was a conclusory allegation that they are
24 statements of opinion and that they are self-serving because the Declarants
25 were employees of the Applicant.

1 So I think on the record it's clear that the Examiner never really addressed
2 the substance of the opinions. He doesn't explain why he feels the
3 Declarations are entitled to no weight, and we feel that on the law that alone
4 mandates a reversal because the law establishes that Examiners are not
5 entitled to --

6 JUDGE CRAWFORD: Well, if by saying that the Declarations are
7 conclusory, it would indicate that the Examiner read them and considered
8 them.

9 JUDGE MOHANTY: He just doesn't consider them persuasive.

10 JUDGE CRAWFORD: Right.

11 MR. VOLK: I guess what the Examiner says is: "Furthermore, Mr. Smith
12 and Mr. Dittmar's conclusions that the references cannot be combined are
13 statements of opinion and not evidentiary fact per se."

14 So he thinks it's a matter of law that they are mere opinion and not fact.

15 JUDGE CRAWFORD: I just disagree with you on saying that the Examiner
16 didn't consider the Declarations. It seems to me the Examiner read the
17 Declarations and didn't find them persuasive.

18 He wasn't going to give them weight because of the fact that he found them
19 conclusory and because of who made the Declarations.

20 I don't see anything, and I haven't been directed to anything that says the
21 Examiner never considered the Declarations. I mean, he had to consider
22 them to come out with that statement.

23 MR. VOLK: The statement is an indication that he feels per se that they are
24 opinions and not evidentiary fact. They are actually evidence as to how
25 people skilled in the art would view the cited references, and we feel the

1 Examiner has an obligation to more substantively address the content of
2 those Declarations.

3 An example there would be the Lemon case in which the Court of Customs
4 and Patent Appeals addressed an issue where they felt the Patent Office's
5 position that declarations from workers in the field regarding how some
6 prior art references can be interpreted -- the Patent Office tried to disregard
7 those as being mere opinions.

8 The Court of Customs and Patent Appeals disagreed and felt they should
9 have been more strongly considered.

10 Another case for this is the Ulrich case in which the CCPA stated in a case
11 where the Patent Office refused to give any substantive weight to four
12 affidavits on the basis that these affidavits are, allegedly, just opinions.

13 The court stated: "To the extent that all of the affidavits expressed opinions,
14 they are the opinions of men considered to be of ordinary skill in the art,
15 based on the information uniquely within their competence bearing on the
16 level of skill in the art at the time the invention was made.

17 "Their conclusions are reasonable and thus more credible in view of the
18 fact" -- only a single word in the disclosure is contrary to those opinions.

19 Also, in the McKenna case the CCPA stated that the declarations should not
20 have been disregarded for being mere opinion and mere statements from
21 Applicants' employees because they should be relied on when sufficiently
22 convincing.

23 In this case the Examiner has not addressed the content of the opinions
24 beyond saying they are opinion per se, and we feel he hasn't addressed the
25 actual arguments in those opinions.

1 JUDGE CRAWFORD: Okay. Any questions?

2 JUDGE MOHANTY: No questions.

3 JUDGE FISCHETTI: No, I don't.

4 JUDGE CRAWFORD: Thank you.

5 MR. VOLK: Thank you.

6 Whereupon, the proceedings at 10:37 a.m. were concluded.

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